



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/647,300

08/26/2003

Eunhyung Kim

Q76059

2617

23373

7590

12/06/2006

SUGHRUE MION, PLLC
2100 PENNSYLVANIA AVENUE, N.W.
SUITE 800
WASHINGTON, DC 20037

EXAMINER

LY, CHEYNE D

ART UNIT

PAPER NUMBER

2168

DATE MAILED: 12/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/647,300

Applicant(s)

KIM ET AL.

Examiner

Cheyne D. Ly

Art Unit

2168

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 21 November 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1-20.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.

Continuation of 3. NOTE: The proposed amendment to claim 2 by deleting the last two lines of the claim has not been entered because said amendment changes the scope of the claim.

Continuation of 11. does NOT place the application in condition for allowance because:

Claims 1-3, 5-7, and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Fernandez (1998).

This rejection is maintained with respect to claims 1-3, 5-7, and 20, as recited in the previous office action mailed August 22, 2006.

On pages 9-11, Applicant argues "the Examiner is attempting to combine the features of three independent programs that run in the Windows. However, it is well settled that different embodiments may not be combined absent suggestion to do so." Ex parte Beuther, 71 USPQ2d 1313, 1316 (BPAI 2003); In re Arkley, 455 F.2d 586, 587-588, 172 USPQ 524, 526 (CCPA 1972). Applicant's argument is not persuasive because "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." Verdegaa Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). As asserted by Applicant the cited applications operate under a single Windows environment, such as Windows 98 (page 61), for example. It is well known in the art that Windows 98 supports the operating of independent applications in a single Windows environment (Perry, pages 16-17).

Second, the claimed invention is directed to "a media file management system" with the open language comprising. The recitation of "...system...comprising" does not limit the claimed invention to a particular software or program. Therefore, the applications running in Windows 98 (system) has been interpreted as "a media file management system...comprising...", as supported by Applicant's argument.

In regard to the citation of Ex parte Beuther, 71 USPQ2d 1313, 1316 (BPAI 2003); In re Arkley, 455 F.2d 586, 587-588, 172 USPQ 524, 526 (CCPA 1972), Applicant's argument is not persuasive because the appealed application and the instant application have different fact patterns. For example, the prior art of record for the instant application is directed to applications running in Windows 98 which has been interpreted as "a media file management system" as recited by the claims. While in the appealed claim, the BPAI did not sustain the standing prior art rejection because the BPAI has concluded "the disclosure [are] not directly related to each other by the teachings of the reference." As cited Fernandez and Perry, the various applications function under a single operating system; therefore, one of skill in the art would have understood that the applications are directly related.

On pages 12, Applicant argues "the Examiner has failed to prove inherency" in regard to the limitation of "a display...in a single screen." Applicant's argument is not persuasive the cited applications operate under a single Windows environment, such as Windows 98 (page 61). It is well known in the art that Windows 98 supports the operating of independent applications in a single Windows environment (Perry, pages 16-17) and comprises multiple windows in a single display screen (Perry, pages 42-43). By citing the secondary reference in Perry, Examiner has established inherency by providing extrinsic evidence that the feature multiple windows in a single display screen is necessarily present in the Windows 98 system disclosed in Fernandez, and that it would be so recognized by persons of ordinary skill.

Claims 1-6, 8-10, 12-16, and 18 are rejected under 35 U.S.C. 102(a) as being anticipated by Rodriguez et al. (US 20030005454A1) (Rodriguez hereafter).

This rejection is maintained with respect to claims 1-3, 5-7, and 20, as recited in the previous office action mailed August 22, 2006.


On page 14-15, Applicant argues that Rodriguez does not disclose the limitation "a display...in a single screen." Applicant specifically points to Figures 13 and 14 to argue that the "search window" and "edit window" are not displayed in a single screen. It is noted that the limitation of "edit" has been attributed with the customary and ordinary meaning of "to modify or add to data or text." Therefore, the disclosure of Rodriguez cited in the previous Office Action reasonably supports that the claimed invention is anticipated by said cited prior art. For example, Applicant's pointed to Figure 14 in Rodriguez describes a "search screen" wherein said search screen comprises a window 1424 that enables the user to enter alphanumeric characters...name of the title, or any of the PRM information and the result display...will display the information..." (page 12, [0087]). The window for entering data or text such as "alphanumeric characters...name of the title" has been reasonably interpreted as the required "edit window" as supported by the customary and ordinary meaning of the limitation of "edit." Therefore, Examiner has presented a prima facie case of anticipation in regard to Rodriguez.

Claims 7, 11, 17, 19, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rodriguez et al. (US 20030005454A1) (Rodriguez hereafter) as applied to claims 1-6, 8-10, 12-16 and 18 above, and further in view of Fernandez (1998).

This rejection is maintained with respect to claims 7, 11, 17, 19, and 20, as recited in the previous office action mailed August 22, 2006.

On page 15, Applicant's argument of "both references are deficient" is not persuasive as the argued limitations have been addressed Fernandez or Rodriguez above.

OK
11/3/06


TIM VO
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100